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10/820,157	04/08/2004	Dong-woo Lee	249/459	7040
27849	7590	12/28/2007		
LEE & MORSE, P.C. 3141 FAIRVIEW PARK DRIVE SUITE 500 FALLS CHURCH, VA 22042			EXAMINER FORD, JOHN K	
			ART UNIT 3744	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/820,157

Applicant(s)

LEE ET AL.

Examiner

John K. Ford

Art Unit

3744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/2/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-8, 10-18 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 14, 15, 17 and 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 11-13 and 22 is/are allowed.
- 6) ☒ Claim(s) 10, 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's RCE filed October 2, 2007 has been studied carefully. It is the examiner's belief that the only real stumbling block to the allowance of this application is applicant's insistence that all of the currently nonelected dependent claims (i.e. claims 6-8, 14, 15, 17 and 18) must be allowed because counsel has amended them to depend directly or indirectly from allowed claims 11 or 12. The problem with this is that neither of claim 11 or claim 12 is generic. In fact, claims 11 and 12 are only readable on the species of Figure 7 because that is the only disclosed species with two coolant storage tanks and both of claims 11 and 12 explicitly recite two coolant tanks.

In support of rejoinder, counsel, without referencing any part of the specification, drawings or original claims states: "In other words, these Species were clearly usable together, and claims 11 and 12 are generic to each of the claims depending therefrom". The examiner disagrees with both statements. First claims 11 and 12 are not generic but rather are only readable on the species of Figure 7 because that is the only disclosed species with two coolant storage tanks and both of claims 11 and 12 explicitly recite two coolant tanks. No other species shows these two coolant tanks. Furthermore in the species of elected Figure 7, the heater 102 is located on the bottom of the heat pipe 100. Importantly, as disclosed on page 18, paragraph 0053, last sentence of applicant's specification, when heating takes place the cooling system is isolated from the heat pipe by fluid control units 126a, 128a and 140a. The heat pipe is heated directly by heater 102.

Non-elected claims 6 and 7

Regarding non-elected claims 6 and 7, the only embodiment that includes this claimed feature (sequential fluid control units) appears to be non-elected Figure 8 (see elements 152a and 152b and paragraph 0058 of the specification). There is nothing that suggests that this feature could be borrowed from the Figure 8 embodiment and inserted into Figure 7 somehow. In fact, Figure 7 uses elements 126a and 140a in a different configuration to perform a similar function. It is therefore unclear, if applicant's substitution is attempted, whether or not 152b would replace 140a or be used in addition to it, or where it would be placed (between the tanks or upstream of them). The high standards set for inherent disclosure under 35 USC 112, first paragraph, set forth in Wagoner v. Barger, 175 USPQ 85 (CCPA 1972) have not been met. A copy of this case law has been attached to this office action and it is incorporated here by reference. If the examiner were to rejoin claims 6 and 7 as depending indirectly from claim 12 the resulting claimed subject matter would not be supported by the original disclosure. According claims 6 and 7 are not rejoined.

Non-elected claim 8

Regarding non-elected claim 8, there is no disclosure to support that either of tanks 144 or 146 have wicks in them or that there is any sort of pressurization device needed. These two features are found in non-elected Figure 4, which bears very little

resemblance to elected Figure 7 and performs the cooling function in a very different manner than Figure 7. The high standards set for inherent disclosure under 35 USC 112, first paragraph, set forth in Wagoner v. Barger, 175 USPQ 85 (CCPA 1972) have not been met. A copy of this case law has been attached to this office action and it is incorporated here by reference. If the examiner were to rejoin claim 8 as depending directly from claim 12 the resulting claimed subject matter would not be supported by the original disclosure. According claim 8 is not rejoined.

Non-elected claims 14 and 15

Regarding non-elected claims 14 and 15, there is no disclosure to support that there is any heater in Figure 7 other than 102. Again, the claimed subject matter of claims 14 and 15 is found in a nonelected species of Figure 9, a species than has no disclosed cooler whatsoever. Again there is no disclosure to link the incorporation of the heaters of Figure 9 into Figure 7. It is open to speculation as to how this might be done and therefore the high standards set for inherent disclosure under 35 USC 112, first paragraph, set forth in Wagoner v. Barger, 175 USPQ 85 (CCPA 1972) have not been met. A copy of this case law has been attached to this office action and it is incorporated here by reference. If the examiner were to rejoin claims 14 and 15 as depending directly from claim 12 the resulting claimed subject matter would not be supported by the original disclosure. According claims 14 and 15 are not rejoined.

Non-elected claims 17 and 18

Regarding non-elected claims 17 and 18, there is no disclosure to support that the cooling system is extend between or overlap or be wrapped around the connection pipe in elected Figure 7. In Figure 7, the two coolers 144 and 146 are placed on the bottom of tanks 134 and 136, respectively. There is no evidence that the species shown in Figure 6 (which discloses that wrapped construction) can be used to wrap tanks 144 and 146. It is open to speculation as to how this might be done and therefore the high standards set for inherent disclosure under 35 USC 112, first paragraph, set forth in Wagoner v. Barger, 175 USPQ 85 (CCPA 1972) have not been met. A copy of this case law has been attached to this office action and it is incorporated here by reference. If the examiner were to rejoin claims 17 and 18 as depending directly from claim 11 the resulting claimed subject matter would not be supported by the original disclosure. According claims 17 and 18 are not rejoined.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In paragraph 0018 of the original specification, it states the enumerated liquids are used as alternatives to one another, not as mixtures. The claim terminology "at least one" to the extent that it claims mixtures of the recited working fluids is deemed to be new matter to the application. Similarly, as disclosed in paragraph 0053, the valve and pump of claim 16 are disclosed as alternatives to one another and are not disclosed as used together in a single control unit (noting that claim 10 claims only one control unit of the three disclosed in Figure 7).

Claims 2, 3, 4, 5, 11, 12, 13 and 22 are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**John K. Ford**  
Primary Examiner



Appendix

Wagoner v. Barger

**Intellectual Property  
Library**

Source: USPQ, 1st Series (1929 - 1986) > U.S. Court of Customs and Patent Appeals > WAGONER AND PROTZMAN v. BARGER AND HAGGERTY, 175 USPQ 85 (C.C.P.A. 1972)

**175 USPQ 85****WAGONER AND PROTZMAN v. BARGER AND HAGGERTY****U.S. Court of Customs and Patent Appeals**

No. 8725

Decided August 24, 1972

350 FSupp 1332

463 F2d 1377

**Headnotes****PATENTS****[1] Interference — Reduction to practice — Constructive reduction (► 41.755)****Specification — Sufficiency of disclosure (► 62.7)**

For application to be entitled to benefit of date of previously filed, copending application such application must contain a written description of invention claimed in second application which complies with first requirement of first paragraph of 35 U.S.C. 112; however, invention claimed in second application need not be described in parent application in *ipsis verbis*; question in cases where parent application does not contain language contained in claims of second application is whether language in parent application is legal equivalent of claim language in the sense that the necessary and only reasonable construction to be given disclosure in parent application by one skilled in the art is same as construction which such person would give claim language.

**[2] Interference — Burden of proof — In general (► 41.051)****Interference — Reduction to practice — Constructive reduction (► 41.755)****Specification — Sufficiency of disclosure (► 62.7)**

Burden of proving that language contained in parent application is legal equivalent of language in claims of later application is on party asserting equivalency, regardless of whether he is junior or senior interference party; burden is a heavy one.

**[3] Interference — Evidence — In general (► 41.351)**

Little or no weight is given to evidence concerning results of tests made by party during interference proceeding without notice to, and in absence of, other party.

**Particular Patents****Particular patents—Film**

3,243,308, Barger and Haggerty, Amylosic Film, award of priority against Wagoner and Protzman application reversed.

**Case History and Disposition**

Appeal from Board of Patent Interferences of the Patent Office.

Patent interference No. 95,734 between John A. Wagoner and Thomas F. Protzman, application, Serial No. 244,127, filed Dec. 12, 1962, and John W. Barger and William J. Haggerty, Jr., Patent No. 3,243,308, issued Mar. 29, 1966. From decision awarding priority to Barger and Haggerty, Wagoner and Protzman appeal.

Reversed.

### Attorneys

FRED S. LOCKWOOD and GREIST, LOCKWOOD GREENAWALT & DEWEY, both of Chicago, Ill. (CHARLES J. MEYERSON and WILLIAM H. MAGIDSON, both of Decatur, Ill., of counsel) for appellants.

WILLIAM D. LUCAS, FRANCIS N. CARTEN, and EYRE, MANN & LUCAS, all of New York, N. Y., for appellees.

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### Judge

Before RICH, Acting Chief Judge, ALMOND, BALDWIN, and LANE, Associate Judges, and CLARK, Justice (Ret.), United States Supreme Court, sitting by designation.

### Opinion Text

#### Opinion By:

RICH, Acting Chief Judge.

This appeal is from the decision of the Board of Patent Interferences in interference No. 95,734 awarding priority to Barger and Haggerty (hereinafter Barger), <sup>1</sup> senior party by virtue of having been given the benefit of the December 15, 1961, filing date of a parent application. <sup>2</sup> Wagoner and Protzman (hereinafter Wagoner) <sup>3</sup> are concededly entitled to the December 12, 1962, filing date of their parent application, <sup>4</sup> but were held below, in a decision from which they did not appeal, not to be entitled to the April 3, 1961, filing date of their grandparent application. <sup>5</sup> Both parties introduced evidence concerning alleged actual reductions to practice prior to their effective filing dates, and Wagoner additionally challenged Barger's entitlement to their parent's filing date. The board held for Barger on the question of support for the counts in their parent application and against Wagoner on the question of the adequacy of their proof of actual reduction to practice prior to Barger's parent filing date of December 15, 1961, and it accordingly did not find it necessary to consider Barger's proofs of alleged actual reduction to practice prior to the December 12, 1962, filing date accorded Wagoner. Wagoner has appealed from both holdings. We reverse and remand.

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<sup>1</sup> Involved on their patent No. 3,243,308, issued March 29, 1966, on application No. 318,159, filed October 23, 1963.

<sup>2</sup> Serial No. 159,752.

<sup>3</sup> Involved on their application No. 501,861, filed October 22, 1965.

<sup>4</sup> Serial No. 244,127.

<sup>5</sup> Serial No. 100,554.

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### Subject Matter of the Counts

There are twelve counts, all of which Wagoner copied in *modified* form from Barger's patent. The first eleven counts define methods of manufacturing films from "amylosic solid materials," and the twelfth defines an article of manufacture made by a process like those recited in the previous counts. The first (paragraphing and emphasis supplied) is illustrative:

1. The method of manufacturing amylosic starch films which comprises forming a composition comprising amylosic solid materials and an amount of water not in excess of about 50% by weight of said composition, heating said composition under pressure at a temperature of at least about 250°F. to convert it into a homogeneous plastic mass and then *extruding* said mass as a self-supporting film *at a temperature not over about 210°F.*

#### I. The Issue of Support in Barger's Parent

Beyond question, Barger's parent application does not contain *express* support for the emphasized recitation. Barger, therefore, relies on the doctrine of inherent disclosure, as set forth, for example, in *Binstead v. Littmann*, 44 CCPA 839, 844, 242 F.2d 766, 769-70, 113 USPQ 279, 281-82 (1957):

It is true, as was stated in *Brand v. Thomas*, 25 CCPA 1053, 96 F.2d 301, 37 USPQ 505 that:

\* \* \* Lack of clear disclosure is not supplied by a speculation as to what one skilled in the art might

do or might not do if he followed the teaching of the inventor. The disclosure should be clearer that to suggest that one skilled in the art *might* construct the device in a particular manner. \* \* \* (Italics quoted.)

This is not to say, however, that each limitation in an interference count must be expressly set forth in haec verba in the disclosure relied upon. It is sufficient if, as in this case, the specification is so worded that the *necessary and only reasonable* construction to be given the disclosure by one skilled in the art is one which will lend clear support to each positive limitation in the interference count.

[ 1 ] In terms of the statute, 35 U.S.C. 120, this means that, for an application to be entitled to the benefit of the date of a previously filed, copending application such application must contain a written description of the invention claimed in the second application which complies with the first requirement of the first paragraph of 35 U.S.C. 112. In re Ahlbrecht, 58 CCPA 848, 852, 435 F.2d 908, 910-11, 168 USPQ 293, 295-96 (1971). However, as we said in In re Lukach, 58 CCPA 1233, 1235, 442 F.2d 967, 969, 169 USPQ 795, 796 (1971), "the invention claimed [in the later application] does not have to be described [in the parent] in *ipsis verbis* in order to satisfy the description requirement of § 112." See also Martin v. Johnson, 59 CCPA 769, 454 F.2d 746, 750-51, 172 USPQ 391, 394-95 (1972). The question in cases in which the parent application does *not* contain language contained in the claims of the later application is whether the language which *is* contained in the parent application is the legal equivalent of the claim language, in the sense that the "*necessary and only reasonable* construction to be given the

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disclosure [in the parent application] by one skilled in the art," Binstead v. Littmann, *supra*, is the same as the construction which such person would give the language in the claims of the later application.

[ 2 ] The above question is often a difficult one, the correct resolution of which depends upon complex factual inquiries. Clearly, the burden of proving that language contained in the parent application is the legal equivalent of the language contained in the claims of the later application is on the party asserting the equivalency, regardless of whether he is the junior or senior party in the interference, Crome v. Morrogh, 44 CCPA 704, 708, 239 F.2d 390, 392, 112 USPQ 49, 51 (1956), and the burden is a heavy one. As was remarked in the principal opinion in In re Arkley, 59 CCPA 804, 455 F.2d 586, 589, 172 USPQ 524, 527 (1972), and not controverted in either of the other opinions, a "line of cases beginning with Ruschig II \* \* \* have significantly tightened up on the application of the description requirement in the first paragraph of 35 U.S.C. 112 \* \* \*." (Footnote, listing three of these cases, omitted.) See also In re Smith, 59 CCPA \_\_\_\_\_, 458 F.2d 1389, 1394, 173 USPQ 679, 683 (1972).

Turning to the facts of this case, we note at the outset that both parties have treated the critical language of the counts emphasized above as requiring that the temperature of the *film* at the point of extrusion be "not over about 210°F." The only part of Barger's parent specification in which support for this limitation can arguably be found is as follows:

In the following examples, the extrusion was carried out with a standard screw extruder equipped with a sheeting die. A one inch diameter screw extruder was employed and the particular screw design had a compression gain of 1.5 to 1, and the overall length of the screw was twenty inches. The die head was set at openings ranging from 0.001 to 0.004 inch with screw speeds of 40 to 100 rpm. With this equipment, the following temperatures were found to be applicable for satisfactory extrusion:

*Table set at this point is not available. See table in hard copy or call BNA at 1-800-372-1033.*

The inlet temperature specified above applied to one-half of the extruder barrel on the feed end, while the outlet temperature applied to the other half of the extruder barrel to which the sheeting die was attached. A one hundred mesh bronze screen was used between the outlet of the extruder and the die. The gauge pressure at the die head was from 200 to 500 p.s.i..

The film emitted from the die head in our process is highly plastic and contains excess water. This film is then passed directly on to heated rolls where the excess moisture is removed. These rolls are also used to stretch the film to provide an orientation of the film. Depending upon the proper-ties desired, the films may be stretched between about one and five times their original length by suitable adjustment of the roll speeds. The temperature of the heated rolls depends upon film thickness, extrusion rate, and mix composition, and particularly the per cent added water. The temperature of the rolls is adjusted to remove the excess water and normally ranges from about 125 to 200°F.

It will be noted that the temperatures given in Table II refer only to portions of the *extruder* and not to the temperature of the *film* as it is extruded, to which the count refers.

Wagoner's contention that Barger's parent application does not support the counts with respect to this limitation was first ruled on by the primary examiner. He denied Wagoner's motion to deny Barger the benefit of their earlier filing date based on this contention, with the following explanation:

The amylosic film disclosed on page 4 of the earlier filed Barger et al. application is only .001 to .004 thousandths of an inch [sic] in thickness. When such a paper-thin film is extruded through a die having a minimum temperature of 190°F. it would be reasonable to conclude that it would become cooled to a temperature "below about 210°F.

Wagoner renewed this contention before the board and lost again. The board stated that it "[found] no error in the reasoning set forth by the Primary Examiner in \* \* \* [holding] that the disclosure of the prior application was sufficient to support the counts" and that it "agree[d] with the examiner in his conclusion that the extrusion of a film of 0.001 to 0.004 inch thickness would have essentially the same temperature as the die through which it was extruded \* \* \*." The board went on to say that it "[found] no convincing evidence of record which would tend to rebut such a conclusion."

We think that the primary examiner erred in focusing on the *lower* limit of the temperature range set forth in Barger's parent and that the board erred in placing the burden of proof concerning this point on Wagoner rather than on Barger. According to our precedents, the burden should have been

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placed on Barger to prove that one skilled in the art would necessarily obtain extrusion of film "at a temperature not over about 210°F." employing any combination of the variables set forth in Barger's parent—or, in other words, not simply that one skilled in the art *might* come within the scope of the count in following the teachings of the parent application, but that he *necessarily* would. Thus, for Barger to obtain the benefit of the filing date of the parent application, the proof had to show that a person of ordinary skill in the art would *necessarily* obtain extrusion of film "at a temperature not over about 210°F." although he employed a set-up in which (1) a standard screw extruder having the characteristics set forth in the specification was driven at 100 rpm, (2) the sheeting die was set to an opening of 0.004 inches, (3) the outlet temperature of the extruder was 360°F., and (4) the die temperature was maintained at 210°F. (not 190°F.). Obviously, an inquiry into this question would also have to take into consideration the meaning to be given the word "about" in the limitation at bar.

To prove that the description of this aspect of the invention contained in Barger's parent application inherently supports the limitation of the counts, Barger relies principally upon evidence concerning certain specific experiments allegedly conducted by Barger. Wagoner moved below to strike Barger's testimony for various reasons which need not concern us here, but the board specifically declined to consider that motion, preferring to base its decision on its own, a priori, technical reasoning. Neither party sought *reconsideration* of the board's decision *not* to decide that issue, and neither party has briefed the issue or in any way sought to obtain from us a ruling on Wagoner's motion. Compare *Myers v. Feigelman*, 59 CCPA 834, 455 F.2d 596, 604, 172 USPQ 580, 587 (1972). Nevertheless, Wagoner questions the propriety of the court's consideration of the above-mentioned evidence and other evidence concerning certain *ex parte* tests conducted by Barger during the course of the litigation.

The procedural history set forth in the previous paragraph might well have left us in a position which we could have resolved only by *remanding* the case to the board to obtain its ruling on Wagoner's motion to strike or by asking the parties for post-hearing briefs on it so that we could decide the motion ourselves. However, in this case we believe that we need take neither of the above steps because, even if Barger's evidence is properly before us, it is addressed to the wrong issue and is therefore not dispositive of this appeal.

[ 3 ] In brief, Barger's evidence concerning the experiments allegedly conducted by Barger is, at best, evidence that it is *possible* to obtain film meeting the controverted count limitation while operating somewhere *within* the ranges set forth in their parent application, because Barger did so. Compare *Crome v. Morrogh*, supra, 44 CCPA at 707-08, 239 F.2d at 392, 112 USPQ at 50. Really, it is evidence of actual reduction to practice, not of support for the counts in the parent application, and, while it may be very relevant to the issue *on remand* from the present appeal, it is not pertinent here. As for the other evidence upon which Barger relies, in the first place it is only evidence concerning the results of tests made by one party during the interference proceeding without notice to, and in the absence of, the other party, and it is for that reason alone entitled to little or no weight. IV *Rivise & Caesar, Interference Law and Practice* § 664, "Ex parte Tests During Interference" (1948), and cases cited therein. See also *Congoleum Industries, Inc. v. Armstrong Cork Co.*, 319 F.Supp. 714, 716, 168 USPQ 263, 264 (E.D. Pa. 1970); and *Kraftco Corp. v. Beatrice Foods Co.*, 342 F.Supp. 1361, 172 USPQ 465, 480 (D. N.J. 1971). Moreover, this evidence is subject to much the same objection as applies to the evidence previously discussed.

Wagoner has submitted evidence on this point in the form of expert testimony by the dean of the School of Engineering and Applied Science at Washington University, St. Louis, Missouri. This witness, whose particular field of expertise was directly relevant to this controversy, testified that either complex calculations or difficult measurements were required to ascertain the temperature of materials being extruded through a die slit. While we do not think that the burden was on Wagoner to prove that the temperature of the film in such situations is not necessarily the same as the temperature of the die, this evidence buttresses our suspicion that the board's a priori technical reasoning was in error.

In summary, we conclude that Barger is not entitled to the benefit of the filing date of their parent application and that Wagoner therefore should be regarded as the senior party by virtue of their conceded entitlement to the benefit of *their* parent's filing date.

## II. The Actual Reduction to Practice Issue

The Wagoner briefs, as to this issue, argue only that the board erred in not finding that they had actually reduced to practice subject matter falling within counts 1, 2, 5, and 12, and we accordingly presume that they have abandoned their appeal as to the other counts in this respect.

Wagoner relies on two runs allegedly conducted some time between March 24 and April 24, 1961, and described in a progress

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report authored by one Richard E. Ody, a witness. The board held that the Wagoner record concerning these runs was insufficient to establish a successful reduction to practice, and we agree. Basically, the trouble with Wagoner's evidence is that critical portions of it are second hand. Barger's brief has marshalled effectively Mr. Ody's many candid confessions of ignorance or failure of memory, and it would prolong this opinion unduly to set them forth here. Apparently Mr. Ody wrote the report, but much of the information contained therein was supplied to him by an associate who did not testify and whose absence was not explained in any way. Under the circumstances, we agree with Barger that, "even under the most relaxed of modern standards, the testimony of Ody and the hearsay document of Exhibit 12 [Ody's report] fall far short of proving a reduction to practice \* \* \*."

## Summary

For the foregoing reasons, we conclude that the board erred in holding Barger entitled to the benefit of the filing date of their parent application and in awarding priority to Barger in part on the basis thereof, but we agree with the board that Wagoner failed to prove actual reduction to practice of subject matter falling within any of the counts prior to the date of their parent filing date of December 12, 1962. Accordingly, the sufficiency of Barger's proof of actual reduction to practice prior to the filing date of the Wagoner parent application becomes critical, and we *reverse* and *remand* this case to the board for its consideration thereof.

BALDWIN, Judge, concurs in the result.

- End of Case -

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